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09/738,199	12/15/2000	Daniel C. Castle	10002991-1	1135

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/738,199

Applicant(s)

CASTLE ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21, 23-30, 32 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21, 23-30, 32 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to Request for Continued Examination filed August 30, 2006. Applicant amended claims 1, 10, 13, 27, 36 and 37. Claims 1-19, 21, 23-30, 32 and 35-37 are still pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19, 21, 23-30, 32 and 35-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites, "using heuristic data to determine which advertisements to be disseminated on the pages, including advertisement targeting, advertisement frequency and appropriateness of the advertisement". Applicant's specification teaches recipient (subscriber) heuristic data is read (checked) to determine if any of the candidate advertisements have already been sent to the subscriber, to determine if another delivery of the same, related or similar advertising is appropriate and if it is determined that advertisements have been seen by a subscriber a review of advertiser's ad placement criteria is made. Therefore, according to applicant's specification the heuristic data is used only to determine which advertisement was

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sent to the subscriber or recipient. The data is not used to determine targeting or frequency or appropriateness. According to the specification the appropriateness is determined according to either advertiser demands, expectation or payment or the subscriber's demographic data and the frequency is based on advertiser (see page 7). The claim also recites scanning the page to determine all available advertising location for plurality of advertisement on the page and automatically resizing the chosen advertisements to fit within the available advertising locations determined by the scan. The specification does not teach scanning the page to determine the available advertising locations. According to the specification the advertising and content delivered to each subscriber, the amount of space available for content and ads will likely vary dynamically as articles and ads are selected. The specification discloses "(i)n step 116, advertisements in the ad poll, which comport with subscriber demographic data in SDF, and content that matches the demographic data determine the amount of space available for advertising. As a first step in selecting ads, those ads in the pool 102, 104, 106 and 108, which will fit with available space are selected, identified or marked as candidates for publication in step 116 because they will fit within available advertising space. Alternatively, an advertiser might specify the size of a placed ad or, where the ad appears in the publication (see page 5). On page 7, the specification discloses, after the method places a candidate advertisement for actual publication in step 126, the method step 134 re-considers whether any other advertising space is left to be filled. If advertising space remains to be filled, program control returns to step 116 whereat advertisements remaining in the pool are subjected to the steps thereafter and if all ads have been placed, the document which includes content information can be delivered or

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otherwise made available to the subscriber". However nowhere in the specification is disclosed that the page is created and then scanned for all available advertising locations.

Independent claims 10, 13, 27 and 36 recite, the same limitation therefore, the above stated rejection applies.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 12 are rejected under 35 U.S.C. 102(e) as being clearly by Markowitz et al.
(US 6,311,185).

Regarding claims 10 and 12, Markowitz teaches receiving a publication into which advertising material as an advertisement to be placed for publication using a predetermined methodology (see fig. 3, abstract, col. 2 lines 19-36, col. 3 line 65 to col. 3 line 18); using heuristic data to determine which advertisement to be disseminated on the page in on-line publication, including targeting, frequency and appropriate of the advertisement (see col. 3 lines 1-17); scanning the page to determine all available advertisement locations and placing the ads on all the available locations and resizing the content and to fit within the available space on the page (see abstract, col. 2 lines 19-30, col. 3 lines 19-50, col. 4 lines 1-45); automatically resizing the advertisement corresponding to an advertiser to fit within a publication space on the page and automatically resizing at least one of the existing content to fit within available space on the page

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(see col. 3 line 19 to col. 4 line 15). Markowitz teaches wherein the steps are performed an Internet service provider (see 2 lines 50-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11, 13-19, 21, 24-30, 32 and 35-37, are rejected under 35 U.S.C. 103(a) as being unpatentable over Markowitz et al. (US 6,311,185) in view of Hanson et al. (US 5,974,398).

Regarding claims 1, 4, 6-9, 11, 13-19, 21, 24-30, 32 and 35 Markowitz teaches identifying at least one subscriber for placing advertisement; using of heuristic data to determine which advertisement to be disseminated on the page in on-line publication, including targeting, frequency and appropriate of the advertisement (see col. 3 lines 1-17); scanning the page to determine all available advertisement locations and placing the ads on all the available locations and resizing the content and to fit within the available space on the page (see abstract, col. 2 lines 19-30, col. 3 lines 19-50, col. 4 lines 1-45). Hanson teaches obtaining offers to place advertisement on a page in an on-line publication; selecting the greatest offer; identifying at least one subscriber to which the page of the on-line publication, according to demographic data; placing on the page of the on-line publication the advertisement; wherein the offers are for a determinable sum (see fig. 13-15, col. 9 line 29 to col. 11 line 5); selecting content information

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based upon subscriber demographic data (see col. 8 line 63 to col. 9 line 23). It would have been obvious to one of ordinary skill in the art at the time of the invention to select the ads of Markowitz based on the highest price, as in Hanson, to maximize the revenue of the service provider.

Regarding claims 2-3 and 5, both Markowitz and Hanson teaches publication distributed for publication using the Internet, wherein the publication is comprised of information obtained from a plurality of sources (see Markowitz col. 2 lines 19-36, col. 3 lines 1-50 and Hanson col. 9 line 62 to col. 10 line 6, col. 11 line 57 to col. 12 line 27).

Regarding claim 36, Markowitz teaches a computer identifying advertisement that comport with the subscriber profile; data storage where the profile information is stored; an interface enabling the exchange of data between advertisers and first computer and between subscribers to said publication and first computer (see fig. 1-4, abstract, col. 2 lines 19-35) using of heuristic data to determine which advertisement to be disseminated on the page in on-line publication, including targeting, frequency and appropriate of the advertisement (see col. 3 lines 1-17); scanning the page to determine all available advertisement locations and placing the ads on all the available locations and resizing the content and to fit within the available space on the page (see abstract, col. 2 lines 19-30, col. 3 lines 19-50, col. 4 lines 1-45). Hanson teaches obtaining offers to place advertisement on a page in an on-line publication; selecting the greatest offer; identifying at least one subscriber to which the page of the on-line publication, according to demographic data; placing on the page of the on-line publication the advertisement; wherein the offers are for a determinable sum (see fig. 13-15, col. 9 line 29 to col. 11 line 5); selecting content information based upon subscriber demographic data (see col. 8 line 63 to col. 9 line 23).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to select the ads of Markowitz based on the highest price, as in Hanson, to maximize the revenue of the service provider.

Claim 37 is rejected as stated above in claim 1.

Response to Arguments

Applicant's arguments with respect to claims 1-19, 21, 23-30, 32 and 35-37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Howard et al. (US 2005/0091109) teaches electronic publishing and delivery based on consumer profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RETTA YEHDGA
PRIMARY EXAMINER

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